

REMARKS

The foregoing amendments and the following remarks are submitted in response to the communication dated December 15, 2004.

Status of the Claims

Claims 3-5, 7-9, 63, 66 and 68 are pending in the application. Claims 3, 4 and 8 have now been cancelled without prejudice to further prosecution. Claims 9 and 63 have now been amended in order to more particularly point out and distinctly claim that which Applicants regard as the invention. New claims 69 and 70 are now presented. Support for the amended claims and new claims can be found generally through Applicants' specification.

New Rejections

New Claim Rejection – 35 USC §112

Claims 3, 4 and 66 are rejected under 35 USC 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular the Examiner objects to the language in claims 3 and 4 encompassing a leptin receptor which is encoded by a nucleic acid which is "identifiable" with a polymerase chain reaction, asserting that "identifiable" under non-specified circumstances does not clearly set forth the metes and bounds. Applicants have above cancelled claims 3 and 4. Applicants note that new claims 69 and 70 now presented, which utilize language similar to prior claims 3 and 4, refer to a "nucleic acid 'amplifiable' in a polymerase chain reaction (PCR) with a probe selected from...". Applicants assert that the term "amplifiable" is clear to the skilled artisan.

Claim 66 is rejected as indefinite because it encompasses a body appearance improving composition of modulating body weight and it is noted as unclear to the Examiner how body weight would be modulated by this compound, up or down. Applicants respectfully disagree and assert that the body appearance improving composition of the claimed invention is understood by the skilled artisan, given their knowledge and the teaching of the specification, to encompass both weight gain and weight loss. A composition of a soluble receptor is anticipated to bind to or otherwise associate with its ordinary ligand and prevent the ligand's interaction with receptor.

Thus, soluble receptors generally antagonize or interfere with the activity of its ordinary ligand. Should this ligand be normal OB polypeptide or leptin, antagonizing of leptin would be expected to result in weight gain. However, should an individual have an abnormal leptin, it could be anticipated that antagonizing a dominant negative leptin, for instance, would result in weight loss. Applicants assert that modulation of body weight, up or down, can be readily contemplated by the skilled artisan and that claim 66 is definite in referring to body weight modulation.

In view of the foregoing remarks, Applicants submit that the Examiner's rejections under 35 U.S.C. 112, second paragraph, may properly be withdrawn.

New Claim Rejections - 35 USC §102

The Examiner has rejected claims 3 and 4 under 35 USC 102(e) as being anticipated by Tartaglia et al [US. Patent 6,506,877, filed December 28, 1995]. The Examiner asserts that the Tartaglia et al. nucleic acid sequence SEQ ID NO: 1 would be identifiable with probes for claims 7, 11, S14 and S3 and therefore anticipates claims 3 and 4. Applicants have above cancelled claims 3 and 4, without prejudice. Applicants submit that this Examiner's rejection under 35 U.S.C. 102 may properly be withdrawn.

Maintained Objections and Rejections

Claim Objections

Claim 9 remains objected to because it encompasses non-elected inventions, which should be deleted, particularly section b) and c). Applicants have above amended claim 9 to delete the non-elected inventions. Applicants submit that the Examiner's claim 9 objection is obviated and should be withdrawn.

The Specification Fully Enables the Claimed Invention

Claims 3-5, 7, 8, 63, 66 and 68 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner remarks that this is a written description rejection and that an adequate written description of a DNA, or encoded polypeptide,

requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention. Applicants respectfully disagree and again assert that the specification provides an adequate written description of the claimed polypeptide sequences. Certain of the rejected claims have above been cancelled, without prejudice to further prosecution. Applicants assert that the claims, including as amended and presented above, are supported by an adequate written description and include, in each case, a sufficiently precise definition by structure, formula, chemical name or physical property.

In view of the foregoing remarks, Applicants submit that the Examiner's rejections under 35 U.S.C. 112, first paragraph may properly be withdrawn.

The 35 USC § 102 Rejection

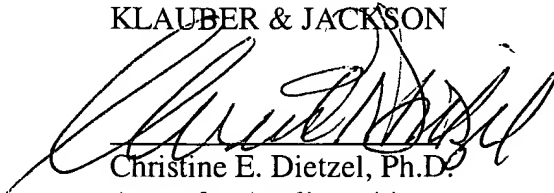
Claims 8, 63, 66 and 68 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tartaglia et al U.S. Patent No. 6,506,877, filed December 28, 1995. The Examiner remarks that claim 8 is anticipated by Tartaglia et al. as broadly written. Applicants have above cancelled claim 8, without prejudice to continued prosecution and have appropriately amended claims 63, 66 and 68 to remove dependency from now cancelled claim 8. Applicants submit that the Examiner's rejection under 35 U.S.C. 102 may properly be withdrawn.

CONCLUSION

Applicants respectfully request entry of the foregoing amendments and remarks in the file history of the instant Application. The Claims as amended are believed to be in condition for allowance, and reconsideration and withdrawal of all of the outstanding rejections is therefore believed in order. Early and favorable action on the claims is earnestly solicited.

Respectfully submitted,

KLAUBER & JACKSON

A handwritten signature in black ink, appearing to read 'Christine E. Dietzel', is written over a horizontal line.

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